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REMARKS/ARGUMENTS

APPLICANTS' TRAVERSE OF RESTRICTION REQUIREMENT

Claims 1, 2, 3, and 5 have been withdrawn without prejudice to Applicants' ability to prosecute these claims in another application.

Applicants elect Group I with traverse. Also, because hydrolase in claim 5 was not made part of the restriction requirement, it is assumed that claim 5 will be examined in its entirety and not just for esterase enzymes.

Applicants respectfully disagree with the restriction and the bases for restriction for the following reasons. The base flaw in the Examiner's argument is that a category called Esterase is lumped in with a small list of specific enzymes. You cannot distinguish a specific enzyme from the class of enzymes called esterases using structure, function and specificity as criteria. If the Examiner abandons Esterases as a member of the class, then where does that leave esterases and hydrolases in the restriction scheme? Further, the Examiner states a conclusion without analysis..

The analysis must begin with MPEP 808.01

[808.01 **>Reasons for Holding of Independence or Distinctness< [R-3]

****>The particular reasons relied on by the examiner for holding that the inventions as claimed are either independent or distinct should be concisely stated. A mere statement of conclusion is inadequate. The reasons upon which the conclusion is based should be given.**

For example, relative to a combination and a subcombination thereof, the examiner should point out the reasons why he or she considers the subcombination to have utility by itself or in other combinations, and why he or she considers that the combination as claimed does not require the particulars of the subcombination as claimed.

Each relationship of claimed inventions should be similarly treated and the reasons for the conclusions of distinctness or

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independence set forth. Form paragraphs 8.01, 8.02, and 8.14-8.20.02 may be used as appropriate to explain why the inventions as claimed are independent or distinct. See MPEP § 806.05 - § 806.06 <]

- A For the restriction to be proper the Examiner must state
- a) Whether this is a normal restriction or a species restriction
 - b) That the enzymes are not disclosed or known to be capable of use together, but
 - c) That they also have different modes of operation, different functions, or different effects.

These criteria have not been met.

I This restriction requirement appears to have the elements of a species restriction, but it is not stated.

II The Examiner has failed to state whether the first requirement has been met or not. Without stating whether the specification or the literature discloses whether the enzymes are capable of use together, the Examiner has not made a case for a restriction requirement.

III The Examiner has failed to state whether the second requirement has been met or not. The Examiner has not stated whether the different enzymes have a) different modes of operation, b) different functions, or c) different effects. Failing to analyze the modes, functions and effects is fatal to a proper restriction requirement. Without making a statement as to a) different modes of operation, b) different functions, or c) different effects the Examiner has failed to make a case for a proper restriction requirement.

Instead the Examiner makes an arbitrary substitute test. The Examiner states that the enzymes are different a) in structure, b) in function, c) in substrate specificity, d) in methods of use and e) in methods of purification.

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<u>MPEP Requirement</u>	<u>Examiner's Test</u>
a) Different Mode	a) Different Structure
b) Different Function	b) Different Function
c) Different Effect	c) Different Specificity
	d) Different Method of Use
	e) Different Method of Purification

None of the three MPEP criteria are analyzed by the Examiner. Further, none of the five substitute criteria are analyzed.

IV Requirements I, II and III must be met to make a restriction requirement. Neither requirement has been made.

Applicants note that in at least one definition of "esterase" the first three requirements; a) different structure, b) different function, c) different substrate specificity are required to differentiate between members of the group. See the definition of ESTERASE at <http://www.wisegeek.com/what-is-esterase.htm> where Esterase is defined as [Esterase is a type of enzyme that causes esters to split into an acid and an alcohol. There are several kinds of esterase. Three factors set each type of esterase apart from the others: substrate specificity, biological function, and protein structure.]

These do not equate to the second requirement for a restriction. Further, if this is true, then all of the enzymes in groups II-VIII are members of the esterase group, which defines group I. In the absence of the first two criteria being met, this restriction is improper because all of the groups are equivalent to or fall within group I.

B. The Examiner has failed to include "Hydrolase", the subject of claim 5 within the scope of any of the groups that are the subject of the restriction requirement.

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It is proper to search all of the enzymes together because there is no clear distinction between for example; modes, functions or effects. One can say what mode, function or effect each enzyme or enzyme in the class uses, but not whether it is distinct from all of the others.

For the reasons given above, Applicants respectfully request that the Examiner withdraw the restriction requirement and either submit a new requirement or search all of the claims together.

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CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this application are in condition for allowance. Examination and issuance of a formal Notice of Allowance at an early date is respectfully requested. If any other issues remain, the examiner is invited to call the undersigned for prompt resolution of the matter.

If needed, Applicants petition for an extension of time under the provisions of 37 CFR 1.136(a) for sufficient time to accept this response. The commissioner hereby is authorized to charge payment of any fees under 37 CFR § 1.17, which may become due in connection with the instant application or credit any overpayment to Deposit Account No.500933.

Respectfully submitted,



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